

Appl. No. 09/912,730
Amdt. dated May 28, 2009
Reply to Office action of January 15, 2009

Remarks/Arguments

The sole issue remaining in this application is whether the subject matter of claims previously presented complies with the statutory requirements of 35 U.S.C. 101. It is the Examiner's position that the claimed subject matter is not a patent eligible process in view of the Court's decision in *In re Bilski*.

In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008) held that a process patent claim, in order to be patentable, must be "tied to a particular machine, or...transforms an article." Furthermore, "the machine or transformation in the claimed process must not be merely insignificant." In the decision, the Court held that the "useful, concrete and tangible result" analysis in *State Street* should no longer be relied on." However, the earlier holding in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) was not entirely overruled.

In its recent decision in *In re Ferguson*, -- F.3d -- (Fed. Cir. 2009), The Court affirmed their holding in *In re Bilski*. However, the Court noted that in *State Street* the claim at issue was drawn to a patent-eligible machine implementation of what may have otherwise been a non-patent-eligible abstract idea, and that their earlier decision in *State Street* "was never intended to supplant the Supreme Court's machine-or-transformation test". Citing *In re Nuijten*, 500 F.3d 1346 (Fed. Cir 2007), the Court stated that "a machine is a 'concrete thing, consisting of parts, or of certain devices and combination of devices.' This 'includes every mechanical device or

combination of mechanical powers and devices to perform some function and produce a certain effect or result'."

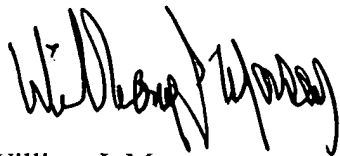
Thus, the above decisions require that a process patent claim meets the requirements of 35 USC §101 if it is tied to a particular machine, and that a machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result . This requirement is met by the claims in this application, particularly as now amended.

Specifically, independent claim 1 explicitly requires electronic communication means having a screen for use by said donor to designate the non-monetary asset being donated and including a list of charities from which the donor can select the charity to receive the contribution . This machine is essential to the practice of applicants' invention, i.e., applicants' claimed method is tied to this machine. The claim covers various types of electronic communications means. However, all electronic communications means inherently include mechanical devices and combinations of devices.

Independent claim 36 goes even further to state that the electronic communication means is an Automated Teller Machine having a screen for use by said donor to designate the non-monetary asset being donated and including a list of charities from which the donor can select the charity . Independent claim 37 specifically requires that the electronic communication means is an Internet website having a screen for use by said donor to designate the non-monetary asset being donated and including a list of charities from which the donor can select the charity to receive the contribution . An Internet website inherently includes devices required to process, store and display the information.

Accordingly, in view of the amendments to the claims and for the foregoing reasons, it is believed that this application is now in condition for allowance. Issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William J. Mason". The signature is written in a cursive style with a large, stylized initial "W".

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